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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/670,056	09/24/2003	Joan T. Gewirtz		4747

7590 10/11/2005  
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EXAMINER

YU, GINA C

ART UNIT PAPER NUMBER

1617

DATE MAILED: 10/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/670,056	<b>Applicant(s)</b> GEWIRTZ, JOAN T.	
	<b>Examiner</b> Gina C. Yu	<b>Art Unit</b> 1617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

*[Handwritten signature]*

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**Claims 1-5 are rejected under 35 U.S.C. 102(b) as being anticipated by Johnstone (US 6262105 B1).**

Johnstone discloses Latanoprost drop in ophthalmic solution is commercially available as Xalatan by Pharmacia & Upjohn. See col. 20, lines 47 – 58. See instant claims 1-3. The recitation “topical use for darkening the color of eyelashes and increasing their length and thickenss” is a preamble which recites the intended future use of the composition, and thus no patentable weight is given to this phrase. See MPEP § 2111.02. Thus, the fact that the composition is sold as glaucoma and ocular hypertension treatment does not negate the fact that the solution is known.

For claim 4, the term “mascara” is not given patentable weight as it is viewed as a preamble which recites the intended use and purpose of the composition rather than

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the constituents of the composition. See MPEP § 2111.02. The term by itself does not define what makes the composition as a mascara. For example, Poucher's Perfumes, Cosmetics and Soaps teaches that "colored pigments mixed with fats and waxes", or "transparent film-forming resin in a suitable base without any pigments" can be used as a mascara. See page 199. Thus examiner views that the term "mascara" denotes the intended use of a composition rather than the structure of the composition.

See above. Thus the liquid composition Xalatan also anticipates claim 4.

The reference further teaches a method of stimulating the growth of eyelashes by administering Xalatan to subject. See Johnstone, Example 1. The reference teaches that in the course of administration the drug is routinely spread to contact the adjacent skin of the lid area. See col. 20, lines 62-67; instant claim 5.

**Claims 1-5 are rejected under 35 U.S.C. 102(e) as being anticipated by Cagle et al. (US 2203/0199590 A1).**

Cagle et al. disclose a composition comprising Latanoprost for darkening the color, increasing the length, density and/or thickness of eyelashes. See [0069]-[0070]; Tables 3 and 4. See instant claim 1. The reference also teaches in paragraph [0056] to make the conventional application of mascara to brush in the composition comprising prostaglandin analogues to the eyelashes. See instant claim 1. The reference goes on to teach to make the composition in solutions, lotions, and topical creams. See [0071]; instant claims 2-4. The topical application to skin, which include eyelid, is taught in paragraph [0070]. See instant claim 5.

**Claims 1-5 are rejected under 35 U.S.C. 102(b) as being anticipated by applicants' own admission.**

Applicants admit in specification that it had been known to the applicants at the time of the present invention that US Patent 6262105 B1 (Johnstone, published July 17, 2002, cited above) teaches that a topical application of Latanoprost drop, Xalatan, to eyeleads to increased length, density, and pigmentation of lashes. See spec. 4 -5.

**Claims 1 and 5 are rejected under 35 U.S.C. 102(e) as being anticipated by Dalko et al. (US 2003/0223945 A1) as further evidenced by Poucher's Perfumes, Cosmetics and Soaps (2000, 10<sup>th</sup> ed).**

Dalko et al. teach making a mascara composition for inducing and/or stimulating the growth of eyelashes comprising an effective amount of a pyridinedicarboxylic acid derivative and at least one additional active principle such as Latanoprost. See [0108], [0115], [0116]. See instant claim 1. The method of applying a mascara composition to eyelash and the eyelids vicinity of eyelash is an inherent use of the composition. See Poucher's Perfumes, Cosmetics and Soaps, p. 50, § 2.12.4, which teaches that it is well known to apply mascara on eyelids and lashes. See instant claim 5.

### ***Conclusion***

No claims are allowed.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gina C. Yu whose telephone number is 571-272-8605. The examiner can normally be reached on Monday through Friday, from 8:30 AM until 6:00 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on 571-272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Gina Yu  
Patent Examiner



SREENI PADMANABHAN  
SUPERVISORY PATENT EXAMINER